REMARKS

Claim 1 has been amended as required on page 2 of the Office action so that n^3 has the possibility of being zero as well as 1-4. The possibility of n^3 being zero is supported by multiple examples in Figure 1. Thus, no new matter has been added and entry of the amendment is respectfully requested.

The only rejections applied to the claims relate to double-patenting.

The first such rejection, over U.S. 6,949,554, was made on the basis of statutory double-patenting, the claims apparently being identical. The claims as printed in the '554 patent, however, are not those that were actually pending and allowed. A Certificate of Correction has been submitted in respect to the '554 patent verifying that the last two lines of the presently pending claims are in fact absent from the claims that should have been printed (copy enclosed). As noted in the Request for a Certificate of Correction, the printed claims appeared in an exhibit to a response to an Office action, and were not the claims that were actually pending in the application. Therefore, the claims pending in this application are not identical to those that actually belong in the '554 patent. Therefore, the rejection is addressed by the enclosed terminal disclaimer.

The second basis for rejection made over U.S. 6,951,862 was for obviousness-type double-patenting, and a terminal disclaimer with respect to that patent is also enclosed.

Applicants recognize that claims are directed to subject matter similar to that claimed in a series of cases from which priority is claimed and in certain cases related to them. Accordingly, the enclosed terminal disclaimer further disclaims the term of the present patent that exceeds that of U.S. 6,011,035; 6,294,533; 6,387,897; 6,617,322; 6,943,168; the two cited patents, 6,951,862; 6,949,554; as well as U.S. patent 7,064,128 and pending applications serial numbers 11/214,218;

10/821,584; 10/928,564 and 10/821,389. Another patent in the family, 7,186,726, contains claims that appear sufficiently different that no terminal disclaimer should be required.

In view of the clarification of the status of the claims in U.S. 6,949,554 and the submission of the enclosed terminal disclaimer, it is believed that the pending claims, claims 1-17, are in position for allowance and passage of these claims to issue is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 381092000623.

Respectfully submitted,

Dated: December 30, 2008 By: / Kate H. Murashige /

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Docket No.: 381092000602
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Terrance P. SNUTCH et al.

Examiner: Raymond James Henley

Art Unit: 1614

Patent No.: 6,949,554

Issued: September 27, 2005

For: CALCIUM CHANNEL BLOCKERS COMRPISING TWO BENZHYDRIL MOIETIES

REQUEST FOR CERTIFICATE OF CORRECTION
PURSUANT TO 37 CFR 1.322

Attention: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

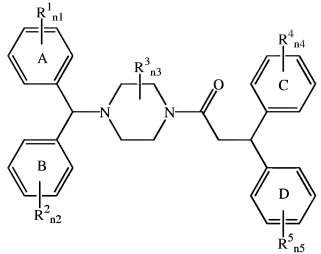
Dear Sir:

Upon reviewing the above-identified patent, Patentee noted the claims are from the parent case and should be corrected.

In Claims 1-17, please make the following corrections:

Beginning at column 28, line 14 delete the following claims as shown in quotations:

"1. A method to treat a condition selected from the group consisting of pain, stroke, epilepsy, anxiety and depression in a subject, which method comprises administering to a subject in need of such treatment an amount of a compound of formula (1) effective to treat said condition wherein said compound of formula (1) is:



(1)

or a pharmaceutically acceptable salt thereof

wherein each R^1-R^5 is independently optionally substituted alkyl (1-10C), alkenyl (2-10C), alkynyl (2-10C), aryl (6-10C), alkylaryl (7-16C) or alkenylaryl (7-16C) each optionally further containing 1-4 heteroatoms (N, O or S) and wherein said optional substituents may include =O; or

each of R^1-R^5 is independently halo, NO_2, SO, SO_2, SO_2NH_2, -OH, SH or NH_2, and wherein R^3 may be keto if $n^3 = 1$; and

wherein two substituents on adjacent positions of the same ring may form a 3-7 membered saturated or unsaturated ring fused to said substituted ring, said fused ring itself optionally substituted and optionally containing one or more heteroatoms (N, S, O); or

wherein a combination of R^1 and R^2 and/or R^4 and R^5 may form a bond or a bridge between phenyl groups A and B and/or C and D; and

wherein each n^1-n^2 and n^4-n^5 is independently 0-4, and n^3 is 1-4; and/or

the compound of formula (1) is in the form of an isolated stereoisomer; or

the compound of formula (1) is P49 or P50 in Figure (1) or a salt thereof.

2. The method of claim 1 wherein each of R^1, R^2, R^4 and R^5 is independently halo, or is optionally heteroatom containing and/or optionally substituted alkyl, alkenyl, aryl, arylalkyl, arylalkenyl, or phenoxy.

3. The method of claim 1 wherein R^1 and R^2 and/or R^4 and R^5 form a bridge of 1-3 members.

4. The method of claim 1 wherein n^3 is 1 and R^3 is COOH or an alkyl ester thereof.

5. The method of claim 1 wherein all of n^1-n^2 and n^4-n^5 are 0.

6. The method of claim 1 wherein one of n^1-n^2 and n^4-n^5 is 1 and the other n are 0.

7. The method of claim 1 wherein one of n^1-n^2 and n^4-n^5 is 2 and the other n are 0.

8. The method of claim 1 wherein one of n^1-n^2 and n^4-n^5 is 3 and the other n are 0.

9. The method of claim 1 which is compound P37-P50 in Figure 1 or a salt thereof.

10. The method of claim 1 wherein the condition is pain.

11. The method of claim 1 wherein the condition is stroke.

12. The method of claim 1 wherein the condition is epilepsy.

13. The method of claim 1 wherein the condition is anxiety or depression.

14. The method of claim 5 wherein the condition is pain.

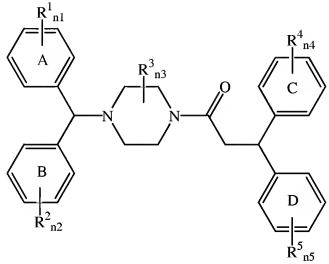
15. The method of claim 5 wherein the condition is stroke.

16. The method of claim 5 wherein the condition is epilepsy.

17. The method of claim 5 wherein the condition is anxiety or depression."

Please insert the following claims as shown within the double hyphen marks:

-- 1. A method to treat a condition selected from the group consisting of pain, stroke, epilepsy, anxiety and depression in a subject, which method comprises administering to a subject in need of such treatment an amount of a compound of formula (1) effective to treat said condition wherein said compound of formula (1) is:



(1)

or a pharmaceutically acceptable salt thereof

wherein each R^1-R^5 is independently optionally substituted alkyl (1-10C), alkenyl (2-10C), alkynyl (2-10C), aryl (6-10C), alkylaryl (7-16C) or alkenylaryl (7-16C) each optionally further containing 1-4 heteroatoms (N, O or S) and wherein said optional substituents may include =O; or

each of R^1-R^5 is independently halo, NO_2, SO, SO_2, SO_2NH_2, -OH, SH or NH_2, and wherein R^3 may be keto if $n^3 = 1$; and

wherein two substituents on adjacent positions of the same ring may form a 3-7 membered saturated or unsaturated ring fused to said substituted ring, said fused ring itself optionally substituted and optionally containing one or more heteroatoms (N, S, O); or

wherein a combination of R^1 and R^2 and/or R^4 and R^5 may form a bond or a bridge between phenyl groups A and B and/or C and D; and

wherein each n^1-n^5 is independently 0-4.

2. The method of claim 1 wherein each of R^1, R^2, R^4 and R^5 is independently halo, or is optionally heteroatom containing and/or optionally substituted alkyl, alkenyl, aryl, arylalkyl, arylalkenyl, or phenoxy.

3. The method of claim 1 wherein R^1 and R^2 and/or R^4 and R^5 form a bridge of 1-3 members.

4. The method of claim 1 wherein R^3 is COOH or an alkyl ester thereof.

5. The method of claim 1 wherein all of n^1-n^5 are 0.

6. The method of claim 1 wherein one of n^1-n^5 is 1 and the other n are 0.

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8. The method of claim 1 wherein one of n^1-n^5 is 3 and the other n are 0.

9. The method of claim 1 which is compound P1-P36 in Figure 1 or a salt thereof.

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12. The method of claim 1 wherein the condition is epilepsy.

13. The method of claim 1 wherein the condition is anxiety or depression.

14. The method of claim 5 wherein the condition is pain.

15. The method of claim 5 wherein the condition is stroke.

16. The method of claim 5 wherein the condition is epilepsy.

17. The method of claim 5 wherein the condition is anxiety or depression. --

REMARKS

The claims printed in the present patent are not those that were pending in the present application. In response to the only Office action on the merits, said Office action mailed 21 October 2004, applicants filed a response on 31 January 2005. No amendment was made to the claims as originally filed. However, attached to the Office action as an exhibit was a copy (labeled as such) of a preliminary amendment filed in co-pending application 10/821,584. The claims that were ultimately printed in the patent were those set forth in the exhibit. This was not an amendment to the claims in the present application. Accordingly, applicants believe a Certificate of Correction restoring the claims to those originally filed is in order.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 381092000602.

Respectfully submitted,

Dated: November 4, 2008 By: / Kate H. Murashige /

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sd-448461

PTO/SB/44 (04-05)
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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 6,949,554

APPLICATION NO. : 10/746,932

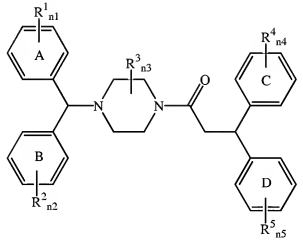
ISSUE DATE : September 27, 2005

INVENTOR(S) : Terrance P. SNUTCH et al.

In Claims 1-17, please make the following corrections:

Beginning at column 28, line 14 delete the following claims as shown in quotations:

"1. A method to treat a condition selected from the group consisting of pain, stroke, epilepsy, anxiety and depression in a subject, which method comprises administering to a subject in need of such treatment an amount of a compound of formula (1) effective to treat said condition wherein said compound of formula (1) is:



(1)

or a pharmaceutically acceptable salt thereof

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wherein two substituents on adjacent positions of the same ring may form a 3-7 membered saturated or unsaturated ring fused to said substituted ring, said fused ring itself optionally substituted and optionally containing one or more heteroatoms (N, S, O); or

wherein a combination of R^1 and R^2 and/or R^4 and R^5 may form a bond or a bridge between phenyl groups A and B and/or C and D; and

wherein each n^1-n^2 and n^4-n^5 is independently 0-4, and n^3 is 1-4; and/or

the compound of formula (1) is in the form of an isolated stereoisomer; or

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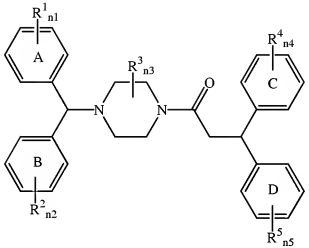

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